



I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS: Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: January 29, 2009

Signature:


(Raymond B. Churchill, Jr.)

Docket No.: SONY 3.0-014
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Gregory D. Gudorf

Application No.: 09/785,094

Group Art Unit: 2457

Filed: February 16, 2001

Examiner: H. A. El-chanti

For: METHOD AND SYSTEM FOR REMOTE
ACCESS OF PERSONAL MUSIC

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby files this reply brief in response to the
Examiner's Answer Brief mailed December 9, 2008.

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	i
I. ARGUMENT	4
A. The Specification Fully Satisfies The Written Description Requirement Of 35 U.S.C. § 112 With Respect To The Objected To Subject Matter Of Claims 52-55.	4
B. Applicant's Documentary And Testimonial Evidence Of A Prior Conception Properly Disqualifies The Van Zoest Reference.	5
C. Van Zoest Does Not Disclose All Elements of Applicant's Invention.	9
II. CONCLUSION	12

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Hiatt v. Ziegler</i> , 179 U.S.P.Q. 757, 763 (B.P.A.I. 1973)	6
<i>Ex parte Ovshinsky</i> , 10 U.S.P.Q.2d 1075 (B.P.A.I. 1989)	6, 7
<i>W.L. Gore & Assocs., Inc. v. Garlock, Inc.</i> , 721 F.2d 1540, 1550 (Fed. Cir. 1983)	10

Statutes, Rules & Other Authorities

35 U.S.C. § 102	9
35 U.S.C. § 102	13
37 C.F.R. § 1.131(b)	8
35 U.S.C. § 112	4, 5, 13
M.P.E.P. § 715.07 I	6, 8
M.P.E.P. § 2163.I.B	4

I. ARGUMENT**A. The Specification Fully Satisfies The
Written Description Requirement Of
35 U.S.C. § 112 With Respect To The
Objected To Subject Matter Of Claims 52-55.**

In response to Applicant's argument A, the Examiner asserts that the Applicant's specification does not show support for the feature in claims 52-55 that "the central location is configured to permit concurrent submission of the authentication information of the user and audio file information." (Examiner's Answer Br. 14.) More specifically, the Examiner states that "[i]n fact, the word "concurrent" does not appear anywhere in the disclosure of the application." (*Id.* at 14-15.) Applicant submits that there is sufficient support for the "concurrent" feature of Applicant's invention. Moreover, it is of no moment that the exact term is not in the specification. An Examiner cannot reject a claim under § 112 for absence of support on the grounds that the exact language of the claim is not in the specification.

The M.P.E.P. states that "there is no *in haec verba* requirement" for newly added claimed features. M.P.E.P. § 2163.I.B. New claim language can "be supported in the specification through express, implicit or inherent disclosure." *Id.* Therefore, Applicant is not required to use the exact term "concurrent" in the Specification. That feature of concurrency may properly be supported by other express language and may be done either impliedly or inherently. Applicant's specification satisfies this standard.

As stated in Applicant's Appeal Brief, the specification provides:

Accordingly, each user is assigned a unique identification code such that the user (or the entity

to whom the user gives the code) is the only entity that can upload and download music to and from the storage space allocated to the user. This identification code is sent with, or before, the steps of uploading and downloading and is used to verify that the requester is the user associated with the particular storage space. (See, e.g., Applicant's Specification ¶ 31 (page 10, lines 7-14) (emphasis added).)

That the identification code used for verification is expressly disclosed as being able to be sent with the uploading or downloading, is a clear expression of an action taken concurrently. Accordingly, Applicant submits that the specification does provide "express, implicit or inherent disclosure" of the "concurrently" feature.

As such, the specification fully satisfies the written description requirement of 35 U.S.C. § 112, first paragraph with respect to the objected-to subject matter of claims 52-55. For at least these reasons, Applicant submits that the Examiner's arguments are insufficient to support a rejection under 35 U.S.C. § 112, first paragraph. Thus, the Examiner's rejection should be reversed.

B. Applicant's Documentary And Testimonial Evidence Of A Prior Conception Properly Disqualifies The Van Zoest Reference.

In response to Applicant's argument B, the Examiner has argued that "the evidence submitted on Oct. 24, 2005 is insufficient to establish conception of the invention prior to the effective date of the Van [Zoest] reference." (Examiner's Answer Br. 15.) The Examiner states that "[t]he authentication with a user name and password concept that would associate a user to particular audio files based on the user 'log in' information is not 'clearly' shown in Exhibit A" and that Exhibit A does not show the concept of associating user authentication information with audio files and transmitting the

audio files to the device based upon the receiving of the authentication information." (*Id.*) The Examiner further states that "[t]he audio files of Exhibit A may simply be uploaded to a webpage which is accessible to any user on the internet without use of any authentication information." (*Id.* at 16.) Applicant submits that the Examiner's conclusion is incorrect at least on two grounds. First, in wholly ignoring submitted declaration evidence, the Examiner is applying an incorrect standard to the question of prior conception. Secondly, when properly considering all of the evidence, the Applicant has established conception prior to the effective date of the Van Zoest reference.

First, in the Examiner's discussion, it is apparent that he has limited his evidentiary analysis to a summary document attached to Exhibit B1 that is entitled "Your Music Anywhere." This documentary evidence was attached to each of the declarations submitted by Applicant. However, the Examiner's answer wholly ignores the additional content of the testimony of the declarations including at least the Declarations of Greg Gudorf (Exhs. B1, B5) and Marc Bekwitt (Exh. B4) on the issue of conception. The law does not require a complete express disclosure of all features in the prefiling documentary evidence alone. "Conception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 U.S.P.Q. 757, 763 (B.P.A.I. 1973). Support for prior conception may be explained by documentary evidence in addition to "statements by witnesses, where verbal disclosures are the evidence relied upon." M.P.E.P. § 715.07 I (citing *Ex parte Ovshinsky*, 10 U.S.P.Q.2d 1075 (B.P.A.I. 1989)). In this regard, an accompanying exhibit need not support all claimed

limitations, provided that any missing limitation is supported by the declaration itself. In this appeal, the Examiner is making the very same legal error that the Examiner made in the *Ovshinsky* case.

The Board in *Ex parte Ovshinsky* expressly held that:

Apparently, the examiner has dissected the evidence and considered only Exhibits A through D in the form of "notes" as having probative value. According to the examiner, these "notes" are appellants' "proofs" and the "proofs" considered alone are insufficient to establish conception of the claimed invention prior to the effective date of the reference. This failure to give probative weight to the Rule 131 declarations constitutes reversible error. We point out to the examiner that (1) all the evidence must be considered in its entirety, including the Rule 131 declarations and accompanying exhibits, records and "notes", (2) an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by the declaration itself. *Ex parte Swaney*, 89 USPQ 618 (PO Bd.App. 1950), and (3) it is entirely appropriate for appellants to rely on a showing of facts set forth in the Rule 131 declarations themselves to establish conception of the invention prior to the effective date of the reference.

Id. at 1077.

In the present examination, the Examiner fails to regard the testimonial content of the declarations of Mr. Gudorf and Mr. Beckwitt in which they expressly describe predating discussions about the conception of claimed features of the invention that the Examiner alleges is missing from the documentary evidence. (Examiner's Answer Br. 16.) In other words, the Examiner is requiring all of the features of the invention to be expressly disclosed in the predated document evidence irrespective of the declarations. Again, Applicant submits that these actions with regard to the evidence submitted by Applicant constitute reversible error.

In short, Applicant's evidence, when considered entirely, is more than "a vague idea of how to solve a problem." (*Id.*) Applicant has not merely rested argument upon general allegations "that the invention was completed prior to the date of the reference." (*Id.*) Exhibits B1 to B4 include "a statement of facts demonstrating the correctness" of the conclusion that Applicant's invention was completed prior to the date of the Van Zoest reference. (See Exh. B1, Declaration of Gregory M. Gudorf; Exh. B2, Declaration of Joseph S. Littenberg; Exh. B3, Declaration of Christopher M. Tobin; Exh. B4 Declaration of Marc Beckwitt.) The Exhibits also include "original exhibits or drawings or records, or photocopies thereof" as required by 37 C.F.R. § 1.131(b). (See, e.g., Exh. B1, Attached Summ. Doc.)

The Examiner is required to "consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and 'notes.'" M.P.E.P. § 715.07 I. As stated in Applicant's Appeal Brief, Mr. Gudorf's declaration confirms the creation of the summary document (attached to his declaration) prior to the filing date of Van Zoest. (Exh. B1 ¶ 4.) Receipt of that document prior to the filing date of Van Zoest was confirmed in the declaration of Chris Tobin, in-house patent counsel for Mr. Gudorf's employer. (Exh. B3 ¶ 2.) The content of that summary document was explained by further evidence in the declarations. Therefore, the Examiner's dismissal of the discussion between Mr. Gudorf and Mr. Beckwitt was incorrect.

Finally, Applicant further submits that even the Examiner's analysis of the documentary evidence alone is faulty. In this regard, the Examiner has argued that the original summary document may have been disclosing "[t]he audio files of Exhibit A may simply be uploaded to a webpage which is accessible to any

user on the internet without use of any authentication information." (Examiner's Answer Br. 16.) The disclosure document submitted October 20, 2005, uses the words "secure" and "qualified device" to describe the transactions in the system for transfer of audio files. (Applicant's Appeal Br. Exh. B1 ¶ 4 (Attached Summ. Doc. 5-8).) For example, the Summary Document uses the language "a secure server" on page 5; "checking for security limitations" and "a qualified Net-enabled device" on page 6; and "secure operation" on page 8. A figure depicting the "Your Music Anywhere" system illustrates the upload, storage and delivery of the person's music files. (Id. (Attached Summ. Doc. 7).) Considering the supporting declarations, the notion of storage on a "secure" system with access by a "qualified" device is inconsistent with the Examiner's contention that the document is describing access by any user of the Internet without authentication.

For at least these reasons, Applicant respectfully submits that the Examiner's continued reliance on the Van Zoest reference as prior art under 35 U.S.C. § 102(e) is improper. Applicant's date of conception prior to the filing date of Van Zoest properly disqualifies the reference. Thus, Applicant requests that the Board reverse the Examiner's rejection and disqualify the reference.

C. Van Zoest Does Not Disclose All Elements of Applicant's Invention.

In response to Applicant's argument C regarding claims 52-53, the Examiner has argued that "Van Zoest teaches a system and method including user identification to a server and in response to the validation of the user identification information, sending the requested work 'audio file' to the user." (Examiner's Answer Br. 17.) The Examiner newly relies on column 20, lines 31-40 and column 20, line 59 to column 21,

line 3 of Van Zoest. In his interpretation of these lines, the Examiner now concludes that "[t]he work 'audio file' is sent to the user based on the user authentication and not based on a user selection from a list." (*Id.*)

However, Van Zoest does not describe a method for storing audio files "wherein the central location is configured to permit concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device." Applicant respectfully submits that the Examiner has misinterpreted Van Zoest by reading statements out of context and by failing to heed details of Applicant's invention. It is improper to take a statement out of the context of the applied reference. Rather, the entire reference must be considered. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983) (District court erred in invalidity determination by "considering the references in less than their entireties.").

The excerpts on which the Examiner now relies describe a system where "a user logs into their account" and "they receive a session identifier." The session identifier is used to generate URLs so that works may be downloaded (Van Zoest col. 20 ll.34-63.) However, this validation process is still necessarily part of a specific system to permit selection of works on a Web site so that the works may be downloaded. In the newly cited text of the reference, Van Zoest states:

[A] user accesses the web site provided by the distributor. While on the site, the user selects a work. Based on the selection, the User Interface Server 120 generates a URL. Next, the URL is provided to the Content Delivery System 152 and the user.

(Id. col.20 11.59-63.) Thus, Van Zoest is clearly describing selecting works from a page on a Web site. In other sections of Van Zoest, which the Examiner now appears to be disregarding, Van Zoest explains what is meant by the "select" language with respect to a user "selecting" a work on a Web site. Van Zoest describes the selection step:

Once the content is acquired or made accessible from a third party, a user can access this content with a personal computer 115, cell phone 116, or any device with Internet access. More specifically, the user accesses the data through the User Interface Server 120. The User Interface Server 120 displays a web page to users that access the system over the network 130. To access the system, the web site preferably requires the user to login before the user is permitted to access the site. FIG. 3 shows an example of a typical login 300, which requires the user to enter a previously assigned user identification and password. Typically, the user identification is freely displayed when entered, but the password is masked to prevent unauthorized user from obtaining an authorized user's password. The login procedure may also permit the user to change their password. Further, if an unauthorized user wants to become an authorized user, the login procedure could provide the unauthorized user with an additional screen(s) requesting information needed to become an authorized user, such as name, address, company, telephone number, credit card number, etc.

Once the user accesses the system, the system offers to provide or distribute a plurality of works to the user over the network 130. The works may include audio, video, audio/video, and many more. The works are preferably musical works, music videos, movies, advertisements and promotions. The list of works is viewable and/or searchable by categories, such as artist, type of work, type of music, type of movie, alphabetical order, etc. The list of works may include a list of promotions, advertisements, infomercials or other promotional works. From this list, the user may **select** the works it wants to receive.

(*Id.* col.11 ll.1-30 (emphasis added).) Clearly, in context, Van Zoest is disclosing selection from a list on a Web page in a manner that is unlike the claimed invention of Applicant.

Simply put, there is no teaching or suggestion in Van Zoest that a song request may be made in any way other than a listing as illustrated in the various lists of the figures. Figures 8 through 19 of Van Zoest depict a song selection list comprising the URLs with incorporated session identifiers. These figures demonstrate that the user is selecting the desired work from a list of choices once the user is on the Web page. Figure 8 describes the list with text stating: "each list view limited to 250 items." Figure 18 describes the user selecting a playlist and the selected songs being copied to the chosen playlist.

Van Zoest does not teach or suggest that the song request may be made without selecting the work from a list of choices. Van Zoest thus requires that a song selection list be transmitted *before* the user is able to submit a request for a work. Thus, Van Zoest does not teach a system which allows for "concurrent submission of the authentication identification information of the user and audio file identification information from the device for transmitting at least one of the audio files to the device, without first transmitting a song selection list to the device."

For at least these reasons, Applicant requests that the Board reverse the Examiner's anticipation rejection of claims 52-53. The Examiner has not established a *prima facie* anticipation rejection since all of the elements of these claims are not disclosed in the Van Zoest reference.

II. CONCLUSION

In sum, for at least the reasons set forth in the Appeal Brief and in this Reply Brief, it is respectfully requested that

the Board reverse the Examiner's present rejections. More specifically, Applicant requests that the Board reverse the Examiner's written description rejection of claims 52-55 in view of the disclosure in the Applicant's specification that satisfies 35 U.S.C. § 112, first paragraph. Applicant further requests that the Board reverse the Examiner's improper reliance on the Van Zoest reference as 35 U.S.C. § 102(e) prior art in view of the Applicant's properly demonstrated conception date prior to the filing date of Van Zoest. Finally, Applicant requests that the Board reverse the Applicant's anticipation rejection of claims 52-55, which are not disclosed or taught in the cited portions of the Van Zoest reference relied upon by the Examiner.

Dated: January 29, 2009

Respectfully submitted,

By 

Raymond B. Churchill, Jr.

Registration No.: 44,617

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant